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09/291,656	03/03/1999	MARC PETERS-GOLDEN	UM-03662	2349

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Medlin & Carroll LLP
101 Howard Street Suite 350
San Francisco, CA 94105

EXAMINER	
CARLSON, KAREN C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/291,656
Filing Date: March 03, 1999
Appellant(s): PETERS-GOLDEN ET AL.

Thomas C. Howerton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 18, 2008 appealing from the Office action mailed March 10, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2007-1145, decided May 30, 2007.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5789441	Gosselin et al.	8-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-25 and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Gosselin et al. (USP 5,789,441; priority to February 15, 1996).

Gosselin et al. teach leukotriene LTB_4 in a sterile liquid (cols. 11-13 and Example I, col. 14, lines 15-16, for example; Claims 22, 23, and 27). The term "LTB_4" includes leukotrienes C_4, D_4, and E_4 (col. 6, line 52; Claims 25, 27).

The Board stated at pages 7 and 8 of their Decision mailed May 30, 2007:

Appellants also argue that the '059 Application does not teach "an aerosol" (Br. 7, 10) and that "[b]ecause 'an aerosol' is not functional language the Examiner MUST give this claim element full patentable weight" *(id.* at 8). In particular, Appellants argue that "an aerosol is a composition of matter within its own right" (Reply Br. 3).

While we agree with Appellants that claim 22's "wherein" clause limits the claim to a solution in the form of an aerosol, we do not agree that that limitation distinguishes the claimed solution from that of Gosselin. Appellants define an "aerosol" as a solution in one of two forms: "a gaseous suspension of fine solid or liquid particles" or a "substance... packaged under pressure with a gaseous propellant for release as a spray of fine particles" (Reply Br. 2).

Gosselin does not disclose a solution in the form of a gaseous suspension or under pressure with a gaseous propellant. However, a solution is not changed by the composition of the gas overlying it or the pressure of that gas. **A solution comprising a leukotriene, an antibiotic, and a sterile liquid vehicle is the same solution regardless of whether the solution is in an open container (i.e., under air at atmospheric pressure) or whether it is "packaged under pressure with a gaseous propellant." Thus, claim 22's limitation that the "solution is an aerosol" does not distinguish the claimed solution from the solution disclosed by Gosselin and the '059 Application.**

Claims 22 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (USP 5,789,441; priority to February 15, 1996).

Gosselin et al. teach leukotriene LTB_4 in a sterile liquid (cols. 11-13 and Example I, col. 14, lines 15-16, for example). The term "LTB_4" includes leukotrienes C_4, D_4, and E_4 (col. 6, line 52).

Gossellin et al. do not expressly teach that to include an antibiotic to a solution comprising a sterile liquid and a leukotriene. However, at col. 5, lines 24-29, Gossellin et al. states that the invention provides for the use of an LTB_4 agent as a therapeutic against Gram + and – infections, or fungal infections alone or in association with other antibacterial or antifungal agents.

Therefore, it would have been obvious to a person having ordinary skill in the art to include an antibiotic in a solution comprising a sterile liquid and a leukotriene (Claim

22, 38), because Gosselin et al. suggests to use LTB_4 with an antibacterial or antifungal agent against Gram+ and – infections, or fungal infections.

The Board stated at pages 7 and 8 of their Decision mailed May 30, 2007:

> Appellants also argue that the '059 Application does not teach "an aerosol" (Br. 7, 10) and that "[b]ecause 'an aerosol' is not functional language the Examiner MUST give this claim element full patentable weight" *(id.* at 8). In particular, Appellants argue that "an aerosol is a composition of matter within its own right" (Reply Br. 3).
>
> While we agree with Appellants that claim 22's "wherein" clause limits the claim to a solution in the form of an aerosol, we do not agree that that limitation distinguishes the claimed solution from that of Gosselin. Appellants define an "aerosol" as a solution in one of two forms: "a gaseous suspension of fine solid or liquid particles" or a "substance... packaged under pressure with a gaseous propellant for release as a spray of fine particles" (Reply Br. 2).
>
> Gosselin does not disclose a solution in the form of a gaseous suspension or under pressure with a gaseous propellant. However, a solution is not changed by the composition of the gas overlying it or the pressure of that gas. A solution comprising a leukotriene, an antibiotic, and a sterile liquid vehicle is the same solution regardless of whether the solution is in an open container (i.e., under air at atmospheric pressure) or whether it is "packaged under pressure with a gaseous propellant." Thus, claim 22's limitation that the "solution is an aerosol" does not distinguish the claimed solution from the solution disclosed by Gosselin and the '059 Application.
>
> We affirm the rejection of claim 22. Claims 23-25 and 27 were not separately argued and fall with claim 22. 37 C.F.R. § 41.37(c)(1)(vii). Since our reasoning differs from that of the Examiner, however, we designate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b) in order to give Appellants a fair opportunity to respond.

(10) Response to Argument

Claims 22-25 and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Gosselin et al. (USP 5,789,441; priority to February 15, 1996).

Appellants urge that Claim 22 is drawn to a sterile vehicle and not to a sterile liquid as taught in Gosselin. One is encompassed by the other, and therefore the statement stands.

Appellants argue that Gosselin et al. does not disclose an aerosol and that this was noted by the Board in their decision mailed May 30, 2007. Therefore, the independent Claim 22 cannot be anticipated. As noted by the Board at pages 7-8 of their decision mailed May 30, 2007:

A solution comprising a leukotriene, an antibiotic, and a sterile liquid vehicle is the same solution regardless of whether the solution is in an open container (i.e., under air at atmospheric pressure) or whether it is "packaged under pressure with a gaseous propellant." Thus, claim 22's limitation that the "solution is an aerosol" does not distinguish the claimed solution from the solution disclosed by Gosselin and the '059 Application.

Because the Board states that the solutions are indistinguishable, then the claimed aerosol solution is anticipated by the solutions taught in Gosselin. Indeed, the Board stated that Gosselin is prior art under 35 USC 102(e) at page 6, bottom, and at page 7, top. Therefore, this rejection of the claims under 35 USC 102(e) is consistent with the wishes of the Board in their decision mailed May 30, 2007.

Applicants present the same argument for the rejection of the dependent claims, that is, that is that Gosselin does not teach aerosol solutions of various leukotrienes and such. See the Boards comments above and in their decision mailed May 30, 2007.

Claims 22 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (USP 5,789,441; priority to February 15, 1996).

Appellants continue (page 7-8) to urge that Gosselin does not teach an aerosol solution and therefore the teachings of Gosselin does not render obvious Claim 22. Appellants are referred again to the Board's statement that the solutions are not distinguishable and therefore that Gosselin anticipates the claimed aerosol solutions.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/Karen Cochrane Carlson, Ph.D./
Primary Examiner, Art Unit 1656

Conferees:
/JON P WEBER/
Supervisory Patent Examiner, Art Unit 1657

/Nashaat T. Nashed/
Supervisory Patent Examiner, Art Unit 1652